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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,583	09/09/2005	Egon Luther	GK-ZEL-3271 / 500343.2029	3812
26418	7590	02/11/2008	EXAMINER	
REED SMITH, LLP			KOVAL, MELISSA J	
ATTN: PATENT RECORDS DEPARTMENT				
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NEW YORK, NY 10022-7650			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,583

Applicant(s)

LUTHER ET AL.

Examiner

Melissa J. Koval

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee U.S. Patent 6,147,797 in view of Spitznas et al U.S. Patent 4,856,872.

Claim 7 sets forth: "A camera adapter (Adapter 80 shown in Figure 2 and also adapter 240 shown in the embodiment of Figure 6 of '797.) for optical devices, such as microscopes (microscope 5 of '797), having an additional image out-coupling element for photographic documentation of images (See Figure 2 with two unmarked connectors leading in/out from a side of the digital camera 90, attached to the microscope, and connected to output unit 100 and computer 110.); said camera adapter to be arranged between the image out-coupling element and a camera and comprising: a housing with two connection pieces, a microscope-side connection piece and a camera-side connection piece (See cylinder 280 of adaptor 240 shown in Figure 6 of '797.); said microscope-side connection piece having a quick-change device; and said camera-side connection piece having a filter thread and eyepiece optics (A variety

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of threaded elements are shown in Figure 6 on opposing sides of the adaptor 240 and cylinder 280 of '797. Also see eyepiece 40 and objectives 30 of '797. Also see Figure 4 and magnifying lens 83a of '797.)."

Lee '797 teaches all of the elements of claim 1, except that Lee does not specifically state that the adapter is a quick change device.

Quick change devices are well known in the art as shown by Spitznas et al. '872.

See the ABSTRACT.

[57]

ABSTRACT

An attachment for microscopes, in particular for stereo-microscopes, facilitates a contact-free viewing of an eye freely movable by the patient, in particular the fundus of the eye. Such an attachment must be easily and quickly attachable to the microscope and must deliver an image section of up to 120°. Moreover, the free movability of the eye must be assured and the attachment must also at high temperature be able to be sterilized quickly, without influencing the wearability of the attachment. This is achieved by an attachment having two lenses or lens systems, the distance between the systems being adjustable and the systems replacing the objective lens of the microscope. The housing of the attachment can be connected to the microscope through a screw or bayonetlike coupling. The outer lens of the attachment is arranged easily movably in axial direction relative to the housing, whereby all reciprocally movable and turnable parts of the attachment are provided with a coating, which consists of pressed and sintered PTFE polymers containing Al_2O_3 particles.

And see column 3, lines 6 through 49, of Spitznas et al. '872.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to fit the microscope of Lee '797 with a quick change adapter as shown by Spitznas et al. '872 to add versatility to the microscope and for the benefit and ease of use of the medical personnel and the patient. The orientation of elements with respect to one another would also be determined by ease of use and design choice.

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Furthermore, one having ordinary skill in the art would be motivated to try the modification with a reasonable expectation of success.

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains' ". KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determination including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also KSR, 127 S. Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18, 148 USPQ at 467. "if a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103." KSR, 127 S. Ct. at 1734, 82 USPQ2d at 1391.

The mere existence of differences between the prior art and the claim does not establish nonobviousness. *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). The issue is "whether the difference between the prior art and the subject matter in question "is a difference sufficient to render the claimed subject matter unobvious to one skilled in the applicable art." " *Dann*, 425 U.S. at 228-29, 189 USPQ at 261 (citation omitted). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established function." KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

In KSR, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* At 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *graham* reaffirmed the obviousness"). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill would employ." *Id.* The court cautioned that "[a] factfinder should be aware, of course, of the distinction caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.* At 1742, 82 USPQ2d at 1397.

The court noted that "[i]n many fields it may be that there is little discussion of obviousness techniques or combinations, and it often may be the case that market demand , rather than scientific literature, will drive design trends." KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396. "Under the correct analysis, any need or problem known in

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the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.' *Id.* At 1742, 82 USPQ2d at 1397. The Court also noted that "[c]ommon sense teaches...that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.' *Id.* At 1742, 82 USPQ2d at 1397. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

Furthermore, the Supreme Court explained that "{w}hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397. "If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense, "id. And, in such an instance" the fact that a combination was obvious to try might show that it was obvious under §103" *id.*

The level of ordinary skill in the art may be evidenced by the prior art references. In *re* GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (fed. Cir. 1995) ("Although the Board did not make a specific finding on skill level, it did conclude that the level of ordinary skill in the art...was best determined by appeal to the references of record....We do not believe that the Board clearly erred in adopting this approach."); see also *In re Oelrich*, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("the PTO usually must evaluate both the scope and content of the prior art and the level of ordinary skill solely on the cold words of the literature").

In sustaining a multiple reference rejection under 35 U.S.C. §103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. In *re* Bush, 296 F. 2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); in *re* Boyer, 363 F. 2d 455, 458 n. 2, 150 USPQ 441, 444 n.2 (CCPA 1966).

During examination of patent application, a claim is given its broadest reasonable construction consistent with the specification. In *re* Prater, 415 F. 2d. 1393, 1404-05, 162 USPQ 541, 550-51, (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F. 3d 1303, 1312, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* At 1313, 75 USPQ2d at 1326.

Claim 8 sets forth: "The camera adapter according to claim 7, wherein the camera adapter has additional beam-deflecting elements, and wherein the optical axes of the connection pieces enclose an angle of less than 180°."

With respect to claim 8. The ABSTRACT of '872 describes an image section delivered up to 120 degrees.

Allowable Subject Matter

2. Claims 9 through 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. The following is a statement of reasons for the indication of allowable subject matter:

Each and every limitation of dependent claims 9 through 12 are required to patentably distinguish the claims over the prior art of record.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. Crockett U.S. Patent Application Publication US 2002/0197075 A1 teaches an eyepiece to instrument coupler.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa J. Koval whose telephone number is (571) 272-2121. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on (571) 272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK

/Melissa J Koval/
Primary Examiner, Art Unit 2862